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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/531,359

04/13/2005

Kim Hansen

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08/06/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT

PAPER NUMBER

3762

MAIL DATE

DELIVERY MODE

08/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/531,359 | Applicant(s) HANSEN ET AL. | |
| | Examiner MICHAEL KAHRELIN | Art Unit 3762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by Brewer et al. (US 5,700,281, hereinafter "Brewer").

3. In regards to claims 23 and 24, Brewer discloses prompting the user with a first electrode pad prompt (col. 8, lines 54-67), detecting prior to pad placement that the pad is being handled (Fig. 10), prompting the operator to conduct a pad placement action (col. 8, line 60), sensing that the operator has conducted the prompted action (col. 8, lines 54-67), and receiving an ECG signal following the placement (col. 8, line 60).

Please note that Brewer's invention "knows what has been done and what needs to be done," and issues the voice prompts accordingly (col. 8, lines 57-58). Further, the pad correction prompt is to remove a pad liner ("please pull electrodes apart" indicates that the first electrode pad must be separated from the second electrode liner and vice versa), and must not be touching each other ("pull electrodes apart"; col. 8, lines 59-60).

The electrodes are only determined to be in proper contact with the subject if the impedance is that shown in element 414 of Figure 10 and the algorithm has reached the proper progression. As such, each of the other "stages" of Brewer's invention senses that the pads are not in proper contact with the subject.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-22 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer. Brewer discloses the essential features of the claimed invention except for prompting the operator to look at the pictures on the pads, prompting the operator to place the pads as shown by icons on the pads, a pad correction prompt that the pads must not touch clothing, or repeating the prompts until the operator has conducted the prompted action. However, it is well known in the defibrillator art to prompt the operator to look at the pictures on the pads and prompting the operator to place the pads as shown by icons on the pads to provide the predictable results of easy-to-understand and easily accessible instructions, to provide a pad

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correction prompt that the pads must not touch clothing to provide the predictable result of ensuring that the electrodes have intimate and effective contact with the skin, and repeating the prompts until the operator has conducted the prompted action to provide the predictable result of indicating to the user when the directed action has been suitably performed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brewer's invention by providing a means to prompt the operator to look at the pictures on the pads and prompting the operator to place the pads as shown by icons on the pads to provide the predictable results of easy-to-understand and easily accessible instructions, to provide a pad correction prompt that the pads must not touch clothing to provide the predictable result of ensuring that the electrodes have intimate and effective contact with the skin, and repeating the prompts until the operator has conducted the prompted action to provide the predictable result of indicating to the user when the directed action has been suitably performed.

Response to Arguments

7. Applicant's arguments filed 6/1/2009 have been fully considered but they are not persuasive. In regards to claims 23 and 24, Applicant argued that Brewer fails to disclose removing pad liners, but only cautions the user to check the electrodes. However, the Examiner is not relying on the "please check electrodes" prompt disclosed at column 8, lines 66-67 as disclosing this feature, but on the "please pull electrodes apart" prompt disclosed at column 8, line 59. This prompt is consistent with the claim limitations of a prompt to "remove a pad liner" (claim 23) and a prompt "that the pads

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must not be touching each other” (claim 24), because removing the second electrode (comprising the second electrode’s pad and pad liner) from the first electrode necessarily requires removing the *second* pad liner from the *first* electrode (or vice versa). Similarly, removing one electrode from the other is a prompt to make sure the pads are not touching each other (i.e. “apart”). It is noted that the claim language does not require these prompts to be made after the pads are placed on the patient.

8. In regards to claims 25-28, Applicant argued that Brewer fails to disclose issuing a pad correction prompt that the pads must not touch clothing, or even a pad correction prompt. It is respectfully submitted that Brewer does disclose a pad correction prompt (e.g., “please check electrodes”; col. 8, lines 66-67), but fails to disclose the specific prompt that the pads must not touch clothing. However, as indicated in the rejection applied in the Office Action of 2/24/2009, this and similar prompts are well known in the art, as evidenced by Freeman (WO 01/56652; elements 122f-h). See “Non-Final Rejection” of 2/24/2009, paragraph 16. Although Brewer is silent as to this specific prompt, the Examiner maintains that an artisan of ordinary skill could have substituted the known pad-correction prompt that the pads must not touch clothing, as taught by Freeman, with the “please check electrodes” prompt of Brewer to render predictable results. This appears to be a use of a known technique to improve similar methods in the same way. See MPEP 2141(III)(C).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHRELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/
Examiner, Art Unit 3762

/Angela D Sykes/
Supervisory Patent Examiner, Art Unit 3762